

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/696,446 Filing Date: October 24, 2000
Confirmation No.: 3917
First Named Inventor: Carey B. Fan
Assignee: @ Road, Inc.
Examiner: Zand, Kambiz Art Unit: 2132
Attorney Docket No.: M-8917 US

San Jose, California
March 9, 2007

Via EFS-Web
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

In accordance with 37 C.F.R. § 41.37, and in compliance with the requirements of the Notice of Panel Decision from Pre-Appeal Board Review, Applicants hereby submit this Appeal Brief.

(i) Real Party in Interest

The Assignee, @ Road, Inc., is the real party in Interest.

(ii) Related Appeals and Interferences

There are no prior or pending appeals, interferences or judicial proceedings known to Appellant, the Appellant's legal representative, or the Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii) Status of Claims

Claims 1-6, 8-9 and 11-30 are rejected and appealed. Claims 7 and 10 are canceled.

(iv) Status of Amendments

No amendment was filed after the Final Office Action of April 21, 2006.

(v) Summary of Claimed Subject Matter

According to Claim 1, a messaging method of the present invention includes (a) generating a message from a mobile device, the message having significance independent of reporting a geographical location of the mobile device; and (b) attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message. Claim 1 is illustrated, for example, in Applicant's Specification, at page 6, lines 8-17.

According to Claim 17, a system (including a mobile device) of the present invention includes (a) a transmitter, illustrated, for example, in Fig. 1 and at Applicant's Specification, at page 4, lines 22-23; (b) a locating device which provides a geographical location of the mobile device, illustrated, for example, in Fig. 1 and at Applicant's Specification, at page 4, lines 22-23; (c) an interface to an application program presented to a user to allow a user generate a message having a significance independent of reporting a location of the mobile device (illustrated, for example, at Applicant's Specification, at page 5, lines 18-27); and a control unit coupled to the transmitter, wherein for each message transmitted from the transmitter (illustrated, for example, in Fig. 1 and at Applicant's Specification, at page 4, lines 22-23), the control unit receives the geographical location from the locating device and attaches a location stamp to an overhead portion of the message indicating the geographical location to the message (illustrated, for example, in Applicant's Specification, at page 6, lines 8-17.).

(vi) Grounds of Rejection to be Reviewed on Appeal

(i) The Examiner's rejection of Claims 1-6, 8-9, 11, 15-25 and 29-30 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 6,456,854 ("Chern"); and

(ii) the Examiner's rejection of Claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Chern, in view of U.S. Patent 6,067,529 ("Ray").

(vii) Arguments

(i) The Examiner's rejection of Claims 1-6, 8-9, 11, 15-25 and 29-30 under 35 U.S.C. § 102(a) as being anticipated by Chern

The Examiner rejected Claims 1-6, 8-9, 11 and 15-25 and 29-30 under 35 U.S.C. § 102(a) as being anticipated by Chern in the Office Action of November 28, 2005 ("Previous Office Action"). In response to the Previous Office Action, Appellants explained in the Response to Office Action of February 28, 2006 ("Previous Response") that independent Claims 1 and 17 each recite that the location timestamp is attached to an overhead portion of each message generated that has independent significance:

1. A messaging method comprising:

generating a message from a mobile device, the message having significance independent of reporting a geographical location of the mobile device; and

attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message.

17. A system including a mobile device, comprising:

a transmitter;

a locating device which provides a geographical location of the mobile device;

an interface to an application program presented to a user to allow a user generate a message having a significance independent of reporting a location of the mobile device; and

a control unit coupled to the transmitter, wherein for each message transmitted from the transmitter, the control unit receives the geographical location from the locating device and attaches a location stamp to an overhead portion of the message indicating the geographical location to the message.

(emphasis added)

Appellants pointed out that the limitations, which are discussed, for example, in Appellants' Specification, on page 9, at lines 6-15, provides significant benefits. In particular, by embedding the location stamp in the overhead portion of the message, the location stamp is transparent to application programs that do not take advantage of the location stamp. As a result, the present invention can be implemented without requiring modification of existing application programs, whether the application program is on the sender's side or on the recipient side. Embedding the location stamp in the overhead portion also prevents maliciously tempering with the location stamp at the application program. Thus, the location stamp may serve also the independently significant function of authentication of the user, for example. For these reasons, Appellants submit that Claims 1 and 17 are allowable over Chern, as Chern neither discloses nor suggest the limitations and their attendant benefits.

In response to Appellants' explanation in the Previous Response, the Examiner first argues in the Final Office Action:

Functionality: as long as the prior art teach the functionality of a process, where such functionality is being executed, then where such execution of the process is being done is irrelevant (in this case, appending the stamp location in the payload or header of a message makes no difference since the prior art do disclose such functionality on fig.4 and as applicant has also admitted in the arguments). Please also see a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing appending location stamp by GPS technology to the message.

Appellants respectfully disagree with the Examiner. By attaching the location stamp to the overhead portion, the structure of the overhead portion of the message is modified. Further, as explained above, as opposed to the payload, attaching the location stamp avoids a

requirement that existing application programs be modified. Thus the limitations of Claims 1 and 17 recite both a difference in structure from prior art messages and a function that is not performed by a message of the prior art. As discussed in MPEP § 2114, no anticipation can be found when there is a structural difference:

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. It should be noted, however, that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999)

Thus, the Examiner's arguments are erroneous and thus should be reversed.

The Examiner then argues:

In response to applicant's argument that Prior art disclose the stamp location in payload of the message and not the header of the message, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The Examiner's arguments here are also erroneous. As explained above, by providing the location stamp in the overhead portion of the message, the structure of the overhead portion of a message is modified. Accordingly, a structural difference is recited. Thus, the Examiner's argument above should be rejected.

Finally, the Examiner states:

Applicant's arguments are not based on the essential element of the Applicant's invention. For example if having location stamp in the header is an inventive step over the prior

art which teach the same functionality as pointed above, but is an inventive steps because result in different structure over the prior art and result in an improvement, then such differences must be specifically be present in the language of the claim and support for such differences should be clearly present in the specification.

Appellants respectfully submit that the Examiner is erroneous. The Examiner does not provide a basis -- and indeed has no basis -- for requiring an “inventive step” for patentability of the pending claims. Neither 35 U.S.C. § 102 nor 35 U.S.C. § 103 requires an “inventive step” for patentability. Thus, Appellants respectfully submit that the Examiner’s requirement of an “inventive step” is not supported by U.S. laws and is therefore illegal and invalid. Moreover, Applicants Claims 1 and 17 specifically recite “attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message” and “attaches a location stamp to an overhead portion of the message indicating the geographical location to the message,” respectively. These limitations represent language that distinguishes over the prior art structurally and results in significant improvement over the prior art (i.e., provides functionality and benefits not found in the prior art). Accordingly, even if the Examiner’s “inventive step” is required under U.S. Patent Laws, Claims 1 and 17 satisfy such a requirement.

Accordingly, Appellants respectfully request the Board to reverse the Examiner’s rejection of Claims 1-6, 8-9, 11, 15-25 and 29-30.

(ii) the Examiner’s rejection of Claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Chern, in view of Ray

In rejecting Claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Chern, in view of Ray, the Examiner states:

15. ... Chern however does not disclose “wherein

the action is a delivery,” “a charge to an account,” or “the charge is a credit card charge.”

16. Referring to the instant claims, Ray teaches that when a consumer makes a purchase, the sales terminal can generate a short message along with the detailed purchase information (Ray: Abstract). A menu can be displayed on the phone and the consumer can select the desired credit card number and request a receipt. The credit card number can be sent along with the transport address or alias address to the sales terminal for authorization of the credit card number (Ray: column 3, lines 52-67; column 4, lines 1-14).

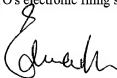
21. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of sending a location identifier with a request from a mobile phone as disclosed in Chern with the method of sending a credit card number across a mobile phone as disclosed in Ray in order to provide substantially immediate purchase information to consumers in a paper-less environment (Ray: column 2, lines 5-7).

Appellants respectfully traverse the Examiner’s rejection. Claims 12-14 and 26-28 depend respectively from Claims 1 and 17, and are thus each allowable over Chern for the reasons stated above. As Ray neither discloses nor suggests providing a location stamp in the overhead portion of a message, as recited in each of Claims 12-14 and 26-28, Appellants respectfully submit that Claims 12-14 and 26-28 are each allowable over the combined teachings of Chern and Ray. Accordingly, the Board’s reversal of the Examiner’s rejection of Claims 12-14 and 26-28 is requested.

Conclusion

All claims (i.e., Claims 1-6, 8-9, 11-30 are therefore believed allowable, and the Examiner's rejections should therefore be reversed. If the Board or the Examiner has any question regarding the above, the Board or the Examiner is respectfully requested to telephone the undersigned Attorney for Applicants at 408-392-9250.

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on March 9, 2007.

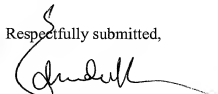


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3/9/2007

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(viii) Claims Appendix

1. A messaging method comprising:

generating a message from a mobile device, the message having significance independent of reporting a geographical location of the mobile device; and

attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message.

2. The method of claim 1, further comprising:

activating a locating device associated with the mobile device to provide the geographical location; and

generating the location stamp corresponding to the geographical location.

3. The method of claim 2, wherein the locating device is a GPS device, and the location is expressed using longitude and latitude values.

4. The method of claim 1, wherein generating the message comprises the user using an application program on the mobile device to generate the message.

5. The method of claim 4, wherein the message includes a voice message from the user.

6. The method of claim 4, wherein the message includes a text message that the user entered.

7. (canceled).

8. The method of claim 1, further comprising transmitting the message from the mobile device to a receiving station.

9. The method of claim 8, wherein the transmitting is via a wireless communication system.

10. (Canceled)

11. The method of claim 8, further comprising determining at the receiving station whether a the geographical location identified by the location stamp corresponds to a predetermined location relevant to an action identified from the message.

12. The method of claim 11, wherein the action is a delivery.

13. The method of claim 11, wherein the action is a charge to an account.

14. The method of claim 13, wherein the charge is a credit card charge.

15. The method of claim 8, further comprising validating an identity of a sender of the message from the location stamp.

16. The method of claim 8, further comprising:

intercepting the message at a processing center before the message reaches the receiving station; and

at the processing center converting the location stamp into a form suitable for the receiving station.

17. A system including a mobile device, comprising:

a transmitter;

a locating device which provides a geographical location of the mobile device;

an interface to an application program presented to a user to allow a user generate a message having a significance independent of reporting a location of the mobile device; and

a control unit coupled to the transmitter, wherein for each message transmitted from the transmitter, the control unit receives the geographical location from the locating device and attaches a location stamp to an overhead portion of the message indicating the geographical location to the message.

18. The system of claim 17, wherein the locating device comprises a global satellite positioning (GPS) device.

19. The system of claim 17, wherein the transmitter comprises a wireless telephone system.

20. The system of claim 17, wherein the geographical location is expressed in terms of latitude and longitude values.

21. The system of claim 20, wherein the message includes a voice message from the user.

22. The system of claim 20, wherein the message includes a text message that the user entered.

23. The system of claim 17, wherein the message from the mobile device is received by a receiving station.

24. The system of claim 17, wherein the transmitter conforms to a protocol of a wireless communication system.

25. The system of 23, wherein the receiving station determines whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to an action identified from the message.

26. The system of claim 25, wherein the action is a delivery.

27. The system of claim 25, wherein the action is a charge to an account.

28. The system of claim 27, wherein the charge is a credit card charge.

29. The system of claim 25, wherein the receiving station validates an identity of a sender of the message from the location stamp.

30. The system of claim 25, further comprising:

a processing center which intercepts the message before the message reaches the receiving station and which converts the location stamp into a form suitable for the receiving station.

(ix) Evidence Appendix

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, and 1.1312 or of any other evidence entered by the examiner and relied upon by Appellant in the appeal.

(x) Related Proceedings Appendix

There is no decision rendered by a court or the Board in any proceeding identified pursuant to 37 C.F.R. § (c)(1)(ii).